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REMARKS

Reconsideration of the application in view of the present amendment is respectfully requested.

Claims 36-40 are pending in the present application. Applicant has made no amendments to claims 36-40.

Applicant would like to respectfully point out that the rejection of claims 36-40 of the present application under 35 U.S.C. Section 103(a) made in the Office Action is improper for reasons explained hereinbelow.

First, Applicant would like to respectfully point out that Kanevsky cannot function as the primary reference in rejecting claims 36-40 of the present application. It should be apparent that if a person of ordinary skill in the art desires to improve an ATM, then that person would begin with a known ATM (i.e., the primary reference would be a known ATM) and then incorporate teachings of another reference (i.e., the secondary reference would have a feature that can be incorporated into an ATM) to improve the ATM. The person of ordinary skill in the art would have no reason to start with a primary reference in which a system unrelated to an ATM (as in Kanevsky) is modified in view of teachings of a secondary reference which does relate to ATMs (as in Suer) to make the system of the primary reference an ATM.

In this regard, Applicant notes from the Office Action that the Examiner specifically states ".....although the Kanevsky reference does not specifically reference an ATM, it operates on systems that provide the same functions as an ATM". In effect, the Examiner appears to argue that because both a POS terminal and an ATM can operate on similar network architectures, a skilled person can therefore start with a POS terminal as the basis for an improved ATM. This is clearly incorrect. While this may be the basis for an argument that a skilled person may start with an ATM and look to a POS terminal to determine how to improve the ATM by taking elements from the POS (because they can both operate on similar network architectures), it would be illogical to postulate that a skilled person would start with a POS terminal and modify it to produce an ATM. There cannot be any motivation

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to choose as a starting point a device that is radically different from the device to be created. In devising an improved ATM, the unimaginative skilled person would always start with an ATM. To do otherwise would require creativity and inventiveness. Accordingly, it is respectfully submitted that Kanevsky cannot function as the primary reference in rejecting claims 36-40 of the present application.

Second, Applicant notes from the Office Action that the Examiner makes the following statements to reject claims 36-40 of the present application:

- I. "Given the teaching of Suer et al. (USPN 6,431,439), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Kanevsky by employing the provision of personalized information to the user of an ATM and a portable device."
- II. "This benefits the system because the user of an ATM may be in need of information relating to the area of the machine."
- III. "Further, the system will address a larger number of users by branching out to ATMs in addition to other points of sale while the user may save the information to the portable device."

Based upon statement I above made by the Examiner, it appears that the Examiner relies exclusively on the secondary reference (Suer) to provide the motivation to modify the system of the primary reference (Kanevsky). However, nowhere does the Examiner identify any specific teaching in Suer (i.e., specifically point out text and/or passages in Suer) to make the proposed modification to Kanevsky. The Examiner fails to either explain in detail or specifically point out where the motivation is provided in Suer to make the proposed modification to Kanevsky. Statements II and III above made by the Examiner are merely conclusory statements which provide no substantial evidence of motivation to make the proposed modification to Kanevsky to include an ATM and a portable device.


If the Examiner continues to reject claims 36-40 by modifying the system of Kanevsky in view of teachings of Suer, it is respectfully requested that the Examiner

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specifically point out where the motivation is provided in Suer (i.e., identify text and/or passages in Suer) to modify the system of Kanevsky to include an ATM and a portable device. In fact, Applicant submits that there is no motivation in Suer to modify the system of Kanevsky to include even an ATM, let alone an ATM and a portable device. Absent an adequate explanation, it is respectfully submitted that the rejection of claims 36-40 of the present application under 35 U.S.C. Section 103(a) is improper and, therefore, should be withdrawn.

In view of the foregoing, it is submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Respectfully submitted,



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